

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAILED

JUN 28 2002

Ex parte TETSURO MOTOYAMA

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application No. 09/192,583

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

The application was received at the Board of Patent Appeals and Interferences on June 19, 2002. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

Appellant filed on June 1, 2000 (Paper No. 2) and on April 9, 2001 (Paper No. 7) Information Disclosure Statements. It is not apparent from the record that the examiner considered the Lists of Related Cases contained in the Information Disclosure Statements that were submitted nor notified appellant in writing that they had been considered.

A Final Rejection was entered on July 5, 2001 (Paper No. 10). In the Final Rejection on page 9, item 28, first paragraph, the examiner fails to list claim 45 as one of the claims being rejected under 35 U.S.C. 103(a) as unpatentable over the combined system of Kuwabara -McCormick in view of Miyachi. However, on page 10, item 28, second paragraph, the examiner discusses claim 45 as being included in the rejection. This same problem occurs in the Examiner's Answer, which was entered on January 15, 2002 (Paper No. 14). In the Examiner's Answer, page 10, item 26, first paragraph, claim 45 is not included in the listing for the rejection. However, on the same page, item no. 26, second paragraph, claim 45 is included in the rejection. Issue no. 3, on page 3 of the Appeal Brief that was submitted by applicant on December 21, 2001 (Paper No. 15), does not list claim 45 as included in the rejection. Thus, the status of claim 45 is inconsistent.

Additionally, in the Appeal Brief on page 3, under issue no. 1, claim 48 is not included in the claims being rejected under 35 U.S.C. 103 as unpatentable over Kuwabara in view of McCormick et al. Claim 48, however, is included in the rejection in both the Final Rejection and Examiner's Answer. Thus, the status of claim 48 is unclear.

Moreover, in the Appeal Brief on page 3, under issue no. 2, claim 9 is not included in the claims being rejected under 35 U.S.C. 103 as unpatentable over Kuwabara and McCormick et al in view of Franz. Claim 9, however, is included under that rejection in both the Final Rejection and the Examiner's Answer. Thus, the status of claim 9 is vague.

The Issue section of the Appeal Brief does not contain any mention of the rejection of claim 19 and 41 under 35 U.S.C. 103(a) as being unpatentable over the combined system

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of Kuwabara - McCormick. This rejection, however, is found on page 12, no. 31, in both the Final Rejection and Examiner's Answer.

Lastly, the Examiner's Answer failed to include the required section concerning the issues on appeal.

Accordingly, it is

**ORDERED** that the application is returned to the examiner for consideration of the List of Related Cases contained in the Information Disclosure Statements filed on June 1, 2000 and on April 9, 2001, for notification to appellant of such consideration, for clarifying the status of claims 9, 19, 41, 45, and 48, for presenting the examiner's issues on appeal, and for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
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